

REMARKS

The present application includes pending claims 1-14 and 36-53, all of which have been rejected. In particular, claims 1-10, 12-14, 36-35, 47-53 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 2005/0028208 ("Ellis 208") in view of 6,774,926 ("Ellis 926") and "common knowledge in the art." Claims 11 and 46 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis 208 in view of Ellis 926 and U.S. 6,665,384 ("Daum"). The Applicants respectfully traverse these rejections for at least the reasons previously discussed during prosecution and the following.

I. Claims 1, 36, And The Claims Depending Therefrom

A. Ellis 208

Claim 1 recites, in part, "creating a user-defined schedule of media stored at the first location using the television at the first location; pushing media from the first location to the at least one media peripheral at the second location according to the user-defined schedule of media created at the first location." Claim 36 recites similar limitations.

The claims are clear that a user at a first location, such as a first home, defines and creates a schedule of media, not just a command to record a program that is to be broadcast or indicating a reminder for a particular program. Media is then pushed from the first location, such as the first home, to the at least one media peripheral at the second location, such as a second home, according to the user-defined media lineup created at the first location.

The Office Action relies on Ellis 208 at ¶¶ 99-100 with respect to these limitations. See August 5, 2010 Office Action at page 3. These cited paragraphs of Ellis disclose, however, the following:

In an illustrative system configuration using Internet service system 61, remote program guide access device 24 is a user's personal computer at work, Internet service system 61 is a web server at a cable system headend, and user television equipment 22 at the user's home contains a set-top box on which the user's program guide is implemented. Using this arrangement, the user may access features of the program guide such as **setting reminders or notifications, viewing listings, program recording, setting favorites, parental control, sending messages, polling for status, or any other suitable function.** For example, if a child in the user's home desires permission to watch a parentally controlled program while the user is at work, the user may access a suitable web page provided by Internet service system 61 that allows the user to enter a password and **adjust the program guide parental control settings. The changed settings allowing the child access to the desired program are then automatically transferred from Internet service system 61 to user television equipment 22, while the user is still at work.**

As another example, the user at work may interact with the program guide on user television equipment 22 via Internet service system 61 **to select programs for recording** on the user's home videocassette recorder, or to **schedule program reminders** that will appear on the user's home television or remote program guide access device **just before a program is broadcast.**

Ellis at ¶¶ 99-100 (emphasis added).

As shown above, the cited portions of Ellis 208 disclose that a user may set reminders with respect to programs that are being broadcast and to select broadcast programs to record. Further, the cited portions of Ellis 208 disclose that a user may adjust parental controls to allow a child to watch a broadcast program.

However, there is nothing in the cited portions of Ellis 208 that describes, teaches or suggests that the user him/herself schedules media that is to be sent from his/her location to another location. That is, while the cited portions of Ellis 208 disclose that a user may select programs to record or reminders for particular programs, they do not describe, teach or suggest that the user schedules media to be broadcast. Further, even if one assumes that selecting programs to record is scheduling a media lineup (which the Applicants do not assume), there is nothing in the cited portions of Ellis 208 that describes, teaches or suggests that media is pushed from a first location to a media peripheral at a second location according to the user-defined schedule of media.

Thus, contrary to the assertion in the Office Action, Ellis 208 does not describe, teach, or suggest “creating a user-defined schedule of media stored at the first location using the television at the first location; pushing media from the first location to the at least one media peripheral at the second location according to the user-defined schedule of media created at the first location,” as recited in claim 1, for example. **Notably**, a previous Office Action acknowledges that “Ellis [208] does not explicitly indicate ... defining a schedule of media at a first location using the TV and pushing the media from that location.” See February 2, 2009 Office Action at page 3. For at least these reasons, the Applicants respectfully request reconsideration of the rejection of claims 1, 36, and the claims that depend therefrom.

B. Ellis 926

Claim 1 also recites, in part, “constructing, at the first location, one or more media channels from user selected and scheduled media content; and communicating in a peer-to-peer manner the one or more media channels from the first location to the

second location via a closed and secure communication.” The Office Action acknowledges that Ellis 208 does not describe, teach, or suggest these limitations. See August 5, 2010 Office Action at page 3.

In an attempt to overcome these acknowledged deficiencies, the Office Action cites Ellis 926 at column 1, lines 47-52, column 3, lines 19-29, and column 7, lines 27-37 and lines 49-57. See August 5, 2010 Office Action at page 4.

Notably, the Office Action asserts that Ellis 926 discloses “peer to peer,” but neither the cited portions, nor any other portions, of Ellis 926 mention “peer to peer.” The Office Action has not shown that Ellis teaches “peer to peer” as known to one of ordinary skill in the relevant art at the time of the invention. Further, the Office Action has not explained how “peer to peer” is being interpreted, nor shown how and why Ellis 926 discloses it. Thus, for at least these reasons, the Applicants respectfully request reconsideration of the claim rejections.

Additionally, while Ellis 926 teaches a user scheduling a “broadcast,” and Ellis teaches capturing video and transmitting the captured video, the Office Action has not shown where any of the cited references teaches pushing the “captured video” according to the user schedule from a system of a first user to a system of a second user, let alone to a “media peripheral” communicatively coupled to the system of the second user. The Office Action has not identified the “media peripheral” to which the media is allegedly pushed. Thus, for at least these reasons, the Applicants respectfully request reconsideration of the claim rejections.

Further, the Office Action does not specifically identify in Ellis 926 the claimed “media content” and “one or more media channels” constructed by the user, at the first

location, from the “media content.” Ellis 926 teaches capturing video and transmitting the captured video for delivery to other users. Ellis 926 teaches a user setting a schedule for broadcasting of a personal channel (FIG. 14, screen 196). The schedule information is provided to the “database 54” at “data storage facility 52.” The Office Action has not shown that the system of a first user transmits anything according to the schedule set by the user and held at the “data storage facility 52.” Thus, for at least these reasons, the Applicant respectfully request reconsideration of the claim rejections.

Ellis 926 discloses that a user captures video, and can edit the captured video, but capturing and editing is not the claimed “constructing, at the first location, one or more media channels” in that Ellis 926 does not describe, teach, or suggest that the user schedules the captured video and then constructs a “media channel” from the user selected and scheduled captured video. (see, e.g., FIG. 15) The scheduling is separate and post-editing of the captured video. Further, the scheduling is done separately using the “data storage facility 52” via “screen 196,” and without a subsequent “constructing” step by the user to produce the claimed “one or more media channels”. For at least these reasons, the Applicants respectfully request reconsideration of the claim rejections.

Additionally, the Office Action implicitly acknowledges that neither Ellis 208, nor Ellis 926 describes, teaches, or suggests “communicating in a peer-to-peer manner the one or more media channels from the first location to the second location **via a closed and secure communication.**” See *id.* at page 4. In an attempt to overcome this deficiency, the Office Action asserts “‘official notice’ that communication streams sent over the Internet should be sent over a secure connection.” See *id.*

The Applicants challenge the assertion of Official Notice with respect to “communicating in a peer-to-peer manner the one or more media channels from the first location to the second location **via a closed and secure communication.**” Alternatively, if the Examiner’s assertions are based on the personal knowledge of the Examiner, then under MPEP § 2144.03(C) and 37 C.F.R. § 1.104(d)(2), the Examiner’s assertions must be supported by an affidavit from the Examiner.

According to MPEP § 2144.03(A), Official Notice, without supporting references, should only be asserted when the subjects asserted to be common knowledge are “capable of instant and unquestionable demonstration as being well-known.” That is, the subjects asserted must be of “notorious character” under MPEP § 2144.03(A).

The Applicants respectfully submit that if the subject matter of the Examiner’s assertion of Official Notice had been of “notorious character” and “capable of instant and unquestionable demonstration as being well-known” under MPEP § 2144.03(A), then the subject matter would have appeared during the Examiner’s thorough and detailed search of the prior art.

The Applicants specifically challenge the assertion of Official Notice with regard to “communicating in a peer-to-peer manner the one or more media channels from the first location to the second location **via a closed and secure communication,**” as recited in claim 1. Claim 36 recites similar limitations.

The Applicants respectfully traverse the assertion of Official Notice and submit that the subject matter is not of such “notorious character” that it is “capable of instant and unquestionable demonstration as being well-known.” Under MPEP 2144.03, the Examiner is now obligated to provide a reference(s) in support of the assertion of

Official Notice if the Examiner intends to maintain any rejection based on the assertion of Official Notice.

C. Obviousness Guidelines

Additionally, referring to the PTO's published guidelines of October 10, 2007, with regard to the procedure to be followed by Examiners when making an obviousness rejection, the guidelines recite **seven rationales** supporting an obviousness rejection and give specific findings that **must be made** by an Examiner in order for the Examiner to use the rationale to support a finding of obviousness. These findings are **not optional and must be articulated by the Examiner for the rationale to apply**. The seven rationales are shown below.

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) "Obvious to try"—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior

art reference or to combine prior art reference teachings to arrive at the claimed invention.

If the present rejection is maintained, or any new rejection based on obviousness is asserted, however, the Applicants respectfully request that any subsequent action: 1) **identify the specific Rationale** (i.e., by explicitly indentifying one of **A through G** noted above) in the Guidelines that the Examiner is using to support the obviousness rejection so that the Applicants may more clearly address the Examiner's concerns, and 2) **state on the record** the **required** factual findings to support the Rationale that the Examiner has chosen.

As indicated recently, "[i]t is important for Office personnel to recognize that when they do choose to formulate an obviousness rejection using one of the rationales suggested by the Supreme Court in *KSR* and discussed in the *2007 KSR Guidelines*, they are to adhere to the instructions provided in the MPEP regarding the **necessary factual findings**." See September 1, 2010 Examination Guidelines Update, 75 Fed.Reg. 169.

Indeed, "if a rejection has been made that omits one of the required factual findings, and in response to the rejection a practitioner or inventor points out the omission, Office personnel **must** either withdraw the rejection, or repeat the rejection **including all the required factual findings**." See *id.*

Further, "[s]imply stating the principle ... without providing an explanation of its applicability to the facts of the case at hand is generally not sufficient to establish a *prima facie* case of obviousness." See *id.*

“[T]he Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.” *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

Thus, as indicated above, the Applicants respectfully request that any subsequent Office Action that asserts an obviousness rejection **specifically identify** which rationale it is using, and then provide **the required factual findings** with respect to the rationale.

II. Claims 5 And 40

Claim 5 recites, in part, “powering said media peripheral on or off; scanning said media peripheral in angle about at least one axis of rotation; transferring stored media from the media peripheral to the first system; transferring stored media from the first system to the media peripheral; transferring software from the first system to the media peripheral; transferring status information from the media peripheral to the first system; initiating a test of the media peripheral; initiating a trick mode of the media peripheral; determining whether the media peripheral is within communication range of the second system; putting the media peripheral into a sleep state; or changing a parameter of the media peripheral.” Claim 40 recites similar limitations.

Instead of specifically addressing each and every limitation of claims 5 and 40, the Office Action merely cites Ellis 208 at “¶101” as disclosing all of these limitations. See August 5, 2010 Office Action at page 5.

However, the Office Action does not demonstrate that any of the cited references describes, teaches, or suggests, for example, (1) “scanning said media peripheral in

angle about at least one axis of rotation,” (2) “transferring status information from the media peripheral to the first system,” (3) “initiating a test of the media peripheral,” “initiating a trick mode of the media peripheral,” (4) “determining whether the media peripheral is within communication range of the second system,” (5) “putting the media peripheral into a sleep state,” or (6) “changing a parameter of the media peripheral.” There is nothing in Ellis at “¶101” that describes, teaches, or suggests each and every one of these limitations.

Thus, for at least these reasons, the Office Action has not established a *prima facie* case of unpatentability with respect to claims 5 and 40.

III. Conclusion

In general, the Office Action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. The Applicants expressly reserve the right, however, to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a future rejection).

The Applicants respectfully request reconsideration of the claim rejections. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the undersigned attorney.

The Commissioner is authorized to charge any necessary fees, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

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